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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,468	02/07/2001	Brian Bruun	0459-0527P	2451

2292 7590 06/30/2003

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EXAMINER
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SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/720,468

Applicant(s)

BRUUN ET AL.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this c mmunication app ars on the cover sh et with the c rrespondenc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 46-90 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 46-70, drawn to method for sorting.

Group II, claim(s) 71-86, drawn to apparatus for conveying.

Group III, claim(s) 87-90, drawn to apparatus for storage.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because Group I is specific to a sorting operation, with determination of characteristic and allocations based thereupon, while Group II is specific to conveying with no requisite that items have varying destinations (claim 71 is merely a group of conveyors with loading, unloading, and storage), under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of the method, Group I, is the sortation and its nature of a method of sortation. The special technical feature of the apparatus, Group II, is in its ability to allow items to creep forward on their respective conveyors.

The inventions listed as Groups II and III do not relate to a single general inventive concept under PCT Rule 13.1 because Group II is specific to a conveyor, while Group III is merely a storage unit, which has none of the technical features of Group II such as conveyors, control system, etc, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of the Group II is orienting traveling items. The special technical feature of the Group III, is in storing articles.

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The inventions listed as Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because Group I is specific to a sorting operation, with determination of characteristic and allocations based thereupon, while Group III is specific to storing items, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of the method, Group I, is the sortation and its nature of a method of sortation. The special technical feature of the apparatus, Group III, is in its ability to store items.

Applicant has amended claim 71 to incorporate a recitation of at least part of claim 46. Such has not been effective in achieving withdrawal of the restriction requirement, as claim 71 still has no positive recitation of the trays, which are the purported novelty of claim 46. Claim 1 and claim 71 each define over the art in completely different ways. Such as, claim 71 attempts to define over GB 2,224,147 by utilizing method terminology to recite that the items are placed into trays. However, the system of claim 71, like GB 2,224,147, could be used to convey, for example, blocks of would, given that they were properly marked.

Further, the added subject matter to claim 71 was as follows; "control means for controlling the operation.... according to the method of claim 46". However, there are many parts of the method of claim 46 that could never be effected by a control system. Such as, does the control means itself actually physically put the items into trays? Of course not. How can the method of claim 46 be considered fully invoked by claim 71 when there is no mention of an apparatus means for getting the items into the trays? For this, claim 71 is improper as it is not enabled and wholly nonspecific. Thus, the

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special technical feature of claim 71, in light of the prior art, is means for moving articles from one conveyor to another.

For future reference, Applicant is advised in advance that claim 71, if left as it currently appears, will be objected to for failing to further limit a parent claim (as apparatus recitations hardly contribute to a method claim in any substantial way), and further rejected to because the last two lines are so ambiguous it is not possible to establish the boundaries of the claim, such as what it might cover, and what it might not.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks  
June 26, 2003

  
DONALD K. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600